



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/727,192	11/29/2000	Shobana Biederman	SONY-50P3947	2836

7590

09/09/2005

WAGNER, MURABITO & HAO LLP

Third Floor

Two North Market Street

San Jose, CA 95113

EXAMINER

NAHAR, QAMRUN

ART UNIT

PAPER NUMBER

2191

DATE MAILED: 09/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/727,192

Applicant(s)

BIEDERMAN ET AL.

Examiner

Qamrun Nahar

Art Unit

2191

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is in response to the amendment filed on 6/20/05.
2. The objection to the drawings is withdrawn in view of applicant's submission of replacement sheets.
3. The objection to the disclosure is withdrawn in view of applicant's amendment.
4. The objections to claims 13-17 and 20 are withdrawn in view of applicant's amendment and remarks/arguments.
5. The rejection under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention to claims 9 and 18 is withdrawn in view of applicant's remarks/arguments.
6. Claims 1, 5, 12, 14-17 and 20 have been amended.
7. Claims 1-20 are pending.
8. Claims 1-20 stand finally rejected under 35 U.S.C. 102(b) as being anticipated by McClellan (U.S. 5,619,250).

### ***Drawings***

9. The drawings were received on 6/29/04. These drawings are acceptable.

### ***Response to Amendment***

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 2191

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by McClellan (U.S. 5,619,250).

**Per Claim 1:**

The McClellan patent discloses:

**- a media receiving system communicatively coupled to a digital terminal device, wherein said digital terminal device is a set top box configured with a default application program**

("The present invention relates generally to set top boxes for use in an interactive television system and more particularly to an improved operating system which accommodates system upgrades in real time. The set top box system utilizes a real time, multi-tasking operating system. The system is divided into modules. Each module performs a particular function such as a device driver, system manager, or other system function." in column 3, lines 60-67 to column 4, line 1)

**- a media receiving apparatus coupled to said media receiving system which receives digital storage media, wherein said digital storage media is a memory stick** ("If the system is not suitable for running a particular application program because a module, or device driver, is missing or outdated, the set top box will request that the necessary module be downloaded from the interactive television system. ... Referring now to Fig. 2, a block diagram of the system

Art Unit: 2191

hardware for an enhanced digital audio/video interactive decoding system (40) built in accordance with the present invention is shown. The decoding system (40), or set top box, includes all of the components of the system described in Fig. 1. Additionally, the decoding system includes ... a PCMCIA interface (52) ... The PCMCIA interface (52) allows for the addition of a PCMCIA card slot which accepts PCMCIA cards. The PCMCIA cards could be used to provide a variety of enhancements such as ... system upgrades in the form of additional upgrade modules” in column 4, lines 40-44 and column 7, lines 44-65)

**- a media accessing mechanism coupled to said media receiving apparatus for accessing data contained within said digital storage media, once said digital storage media has been received by said media receiving apparatus; a relaying component coupled to said media receiving apparatus that relays said data contained within said digital storage media to said digital terminal device; and wherein said data is an alternative software application disposed in the root directory of said digital storage media, said alternative software application for assuming operational control of said digital terminal device** (“If the system is not suitable for running a particular application program because a module, or *device driver*, is missing or outdated ... If a data device containing system modules were attached via the PCMCIA interface (52) ..., the CPU could search for system module and include a description record for each module in the configuration description block as described above. The CPU could search the PCMCIA interface (52) ... either at initialization or at a later time. As a practical matter, the system would have to be initialized at least partially such that the device driver modules for the PCMCIA interface (52) ... would be loaded.” in column 4, lines 40-49

Art Unit: 2191

and column 9, lines 35-45; "device driver" is a software that assumes operational control of said digital terminal device. The device driver is inherently disposed in the root directory of the digital storage media.).

**Per Claim 2:**

The McClellan patent discloses:

- wherein said alternative application software program is configured as a stand-alone application software program, said stand-alone application software program adapted to be implemented in said digital terminal device instead of said default application program configured in said digital terminal device (column 4, lines 40-44 and column 7, lines 58-65).

**Per Claim 3:**

The McClellan patent discloses:

- wherein said alternative application software program is configured as an upgrade application software program, said upgrade application software program adapted to be written into said default application program of said digital terminal device, such that said default application is thereby upgraded (column 4, lines 40-44 and column 7, lines 58-65).

**Per Claim 4:**

The McClellan patent discloses:

Art Unit: 2191

- wherein said alternative application software program is configured as a corrective application software program, said corrective application software program is adapted to be written into said default application program of said digital terminal device, such that the portion of said default application program of said digital terminal device functioning improperly is corrected such that proper functionality is restored to said default application program (column 4, lines 40-44 and column 7, lines 58-65).

**Per Claims 5-6:**

These are apparatus versions of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above, including “an opening in said media receiving apparatus adapted to enable said media receiving apparatus to receive media” (column 7, lines 58-65). Thus, accordingly, these claims are also anticipated by McClellan.

**Per Claim 7:**

The McClellan patent discloses:

- wherein said opening of said media receiving apparatus is such that it is integral to said digital terminal device (column 7, lines 44-65).

**Per Claim 8:**

The McClellan patent discloses:

**- wherein said opening of said media receiving apparatus is of a height and width to accept said digital storage media (column 7, lines 44-65).**

**Per Claims 9-11:**

These are apparatus versions of the claimed system discussed above (claims 2-4, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by McClellan.

**Per Claim 12:**

This is a method version of the claimed system discussed above, claim 1, wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, this claim is also anticipated by McClellan.

**Per Claim 13:**

The McClellan patent discloses:

**- wherein said step a) further comprises the step of: inserting said digital storage media into said media receiving apparatus (column 7, lines 44-65).**

**Per Claim 14:**



The McClellan patent discloses:

- wherein said step a) further comprises the step of: a2) applying power to the digital terminal device such that said digital terminal device is thereby turned on, once said digital storage media is received by said media receiving apparatus (column 7, lines 44-65 and column 9, lines 35-45).

**Per Claim 15:**

The McClellan patent discloses:

- wherein said step b) further comprises the step of: b1) disposing instructions within programmable non-volatile memory coupled to said digital terminal device for controlling said accessing of said data contained within said digital storage media, said data containing said alternative application software program to be used by said digital terminal device (column 4, lines 40-44 and column 7, lines 44-65).

**Per Claim 16:**

The McClellan patent discloses:

- wherein step b) further comprises the steps of: b2) initiating said disposed instructions existing within programmable non-volatile memory coupled to said digital terminal device for controlling said accessing of said data (column 8, lines 12-23).

**Per Claim 17:**

The McClellan patent discloses:

**- wherein said step c) further comprises the step of: c1) invoking said data containing said alternative application software program (column 9, lines 35-45).**

**Per Claims 18-20:**

These are method versions of the claimed system discussed above (claims 2-4, respectively), wherein all claim limitations also have been addressed and/or covered in cited areas as set forth above. Thus, accordingly, these claims are also anticipated by McClellan.

***Response to Arguments***

12. Applicant's arguments filed on 6/29/04 have been fully considered but they are not persuasive.

*In the remarks, the applicant argues that:*

a) Claim 1 recites ...

However, as understood by Applicants, McClellan does describe or suggest an "alternative software application for assuming operational control of said digital terminal device" as claimed. Thus, McClellan does not suggest or describe an alternative application for controlling operation of the set top box. Conversely, McClellan, as understood by Applicants, describes the CPU controlling the manner in which the set top box interacts with additional

applications and/or modules that may be contained within a PCMCIA card. Thus, McClellan fails to teach the limitation of "alternative software application for assuming operational control of said digital terminal device" as recited.

Continuing, McClellan does not suggest or describe an "alternative software application disposed in the root directory of said digital storage media," as claimed. While McClellan, as understood by Applicant, may describe additional applications and/or modules disposed on a PCMCIA card, McClellan does not teach an "alternative software application disposed in the root directory of said digital storage media" as recited. ...

Claim 5 recites ... However, McClellan, as understood by Applicant, does not teach "said alternative application software program to be used by said digital terminal device as a substitute for said default application," as recited.

... McClellan does not teach "said data disposed in the root directory of said digital storage media" as recited.

Claim 12 recites ... However, McClellan, as understood by Applicant, does not teach "said data is an alternative application software program to be a substitute for said default application program of said digital terminal device," as recited.

... McClellan does not teach "said data disposed in the root directory of said digital storage media" as recited.

*Examiner's response:*

a) Examiner strongly disagrees with applicant's assertion that McClellan fails to disclose the claimed limitations recited in claims 1, 5 and 12. McClellan clearly shows each and every limitation in claims 1, 5 and 12.

McClellan teaches wherein said data is an alternative software application disposed in the root directory of said digital storage media, said alternative software application for assuming operational control of said digital terminal device ("If the system is not suitable for running a particular application program because a module, or *device driver*, is missing or outdated ... in column 4, lines 40-49; "device driver" is a software that assumes operational control of said digital terminal device. The device driver is inherently disposed in the root directory of the digital storage media.). Furthermore, the same rationale applies for claims 5 and 12.

In addition, see the rejection above in paragraph 11 for rejection to claims 1-20.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2191

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Fridays from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam, can be reached on (571) 272-3695. The fax phone number for the organization where this application or processing is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 2100 Group receptionist whose telephone number is 571-272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



QN  
September 1, 2005



**TUAN DAM**  
**SUPERVISORY PATENT EXAMINER**